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REMARKS

Claims 1-30 are in the case.

Claim 22 has been amended to correct a typographical error.

Claims 1-30 are rejected under 35 U.S.C. 103 (a) as *prima facie* obvious over WO97/33921. The Office Action states, "One of ordinary skill in the art would find it prima facie obvious to utilize a tackfying resin either having a glass transition temperature of greater than 65°C, or a softening point of greater than 140°C from the prior art because these tackfying resins are suggested within the prior art. The prior art identifies tackfying resins with a softening point of being greater than 130°C as being particularly useful."

Applicants submit that WO97/33921 does not teach or suggest the use of a low amount of a tackfying resin having a glass transition temperature (Tg) of greater than 65°C or a softening point of greater than 140°C, that there is no suggestion or motivation to modify WO97/33921 in the manner claimed, and that there is no reasonable expectation of success.

The present invention is directed to a combination of two selections-- the selection of (i) a low amount of (ii) a substantially aliphatic tackfying resin having a Tg of greater than 65°C (claims 1-29), or a softening point of greater than 140°C (claim 30) to achieve an adhesive that exhibits very high heat resistance.

WO97/33921 is directed to hot melt adhesives that includes an interpolymers of ethylene with an α -olefin (page 1, lines 3-6). WO97/33921 discloses that the adhesives may include modifying polymers, tackfying resins, plasticizers, waxes, and other

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additives. WO97/33921 provides laundry lists of modifying polymers (pages 22-23), tackifying resins (pages 23-25), plasticizers (page 25), waxes (pages 25-26), and other additives (pages 26-27). WO97/33921 discloses that tackifying resins range from being a liquid at 37°C to having a softening point of about 135°C (page 24, lines 23-25). There is nothing in WO97/33921 that provides the requisite direction or motivation for the skilled artisan to select a substantially aliphatic tackifying resin having a Tg of greater than 65°C or a softening point of greater than 140°C from among the many general tackifying resins listed by WO97/33921. Moreover, none of the specified tackifying resins in the examples in WO97/33921 have a Tg of greater than 65°C or a softening point of greater than 140°C. To the contrary, the tackifying resins employed in the examples of WO97/33921 have Tgs of 30.9°C (Eastotac™ H-100), 55°C (midpoint Tg, ECR-177 or Escorez 5400, Escorez™ 5300), 45°C (midpoint Tg, Escorez™ 1310), 50°C (midpoint Tg, Escorez™ 2596), 65°C (midpoint Tg, Escorez™ 5320), -15°C (midpoint Tg, Escorez™ 2520), 57°C (Piccotac 115), or a softening point of 97°C (Foral™ 105), or 130°C (Eastotac™ H-130). Accordingly, the skilled artisan, upon reading WO97/33921, would have no reason to select a substantially aliphatic tackifying resin having a Tg of greater than 65°C or a softening point of greater than 140°C.

In addition, Applicants submit that one general disclosure in WO97/33921, as referred to by the Office Action, that "solid tackifying resins with a softening point greater than about 100°C, more preferably with a softening point greater than about 130°C are particularly useful to improve the cohesive strength of the adhesives..." in combination with the particular disclosure that none of the specified tackifying resins have a Tg of greater than 65°C or a softening point of greater than 140°C would not

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provide sufficient guidance for a skilled artisan to select such specific tackifying resin having a Tg of greater than 65°C or a softening point of greater than 140°C. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. Denied 469 U. S. 851 (1984). MPET 2141.02.

Further, as stated in the specification, prior to Applicants' invention, a skilled artisan believes it that higher heat resistance is generally achieved by the use of a higher level of a tackifying resin. (Specification, page. 2, lines 3-5). WO97/33921 is not contrary to the then-accepted knowledge. WO97/33921 does not provide any suggestion or motivation for the skilled artisan to select a lower amount of a tackifying resin than a base polymer to achieve high heat resistance. To the contrary, WO97/33921 discloses that adhesives that include lower levels of tackifying resins exhibit lower heat resistance whereas adhesives including higher levels of the same or similar tackifying resins exhibit higher heat resistance. For example, an adhesive including 25% tackifying resin (Eastontac H-100-R, Tg: 30.9°C, softening point: 100°C) and 40% base polymer exhibits a 100g peel temperature of 48.3°C (page 80, Table Eighteen C, Example 103), whereas an adhesive including 55% the same tackifying resin (Eastontac H-100-R) and 25% base polymer exhibits a 100g peel temperature of about 70°C (page 79, Table Eighteen B, Example 94). Similar results are illustrated in WO97/33921 on page 80, Table Eighteen C, Examples 100-102 and 104, and page 79, Table Eighteen B, Examples 95-102. The specific teaching in WO97/33921 that higher amounts of a tackifying resin having a Tg of less than 65°C, e.g., 30.9°C and a softening point of less than 140°C, e.g., 100°C achieve

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higher heat resistance whereas lower amounts of the same or similar tackifying resins achieve relatively low heat resistance would not provide any guidance for a skilled artisan to select such lower amount of the resin, particularly a resin having a Tg of greater than 65°C and a softening point of greater than 140°C to achieve high heat resistance. Rather, such teaching of WO97/33921 would lead away from the claimed invention. Thus, casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art reference and the then-accepted wisdom in the field, *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000), citing *Dembiczak*, 175 F. 3d at 999, 50 USPQ2d at 1617, a skilled artisan without the knowledge of the claimed invention but with the then-accepted knowledge—higher level of a tackifying resin than a base polymer achieves higher heat resistance, and guided by the only reference WO97/33921--which teaches that higher amounts of a tackifying resin having a Tg of 30.9°C and softening point of 100°C achieve higher heat resistance whereas lower amounts of the same or similar tackifying resins achieve lower heat resistance, would have no reason or desirability to select the lower amount of a resin to achieve high heat resistance. In addition, a skilled artisan would have no reason or desirability to select a specific tackifying resin having a Tg of greater than 65°C or a softening point of greater than 140°C in combination with the selected lower amount to achieve high heat resistance.

The Office Action also states that because applicants' instantly claimed tackifying resins are commercially available and widely utilized tackifying resins, one of ordinary skill in the art would find it prima facie obvious to utilize one of these resins and have it function in an expected manner.

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Applicants submit that an obviousness rejection cannot be maintained on an "obvious to try" assumption absent a showing of motivation. Absent "impermissible hindsight", one of ordinary skill in the art would not have been motivated by WO97/33921 to use the numerous commercially available and widely used tackifying resins in the manner claimed as the results of the present invention showing very high heat resistance using the lower amount of a resin having a Tg of greater than 65°C or a soften point of greater than 140°C would also not have been expected. For example, an adhesive of the present invention including 20% of a tackifying resin having a Tg of 81°C (ECR-158) and 70% a base polymer exhibit a 100g peel temperature of 87°C (Specification, page 24, Ex. 7), whereas an adhesive of WO97/33921 having 20% tackifying resin having a Tg of 30.9°C and 35% base polymer exhibits a 100g peel temperature of 57°C. (WO97/33921, page 74, example 83). Likewise, all the examples in WO97/33921 where lower amounts of a tackifying resin having a Tg of less than 65°C or a softening point of less than 140°C are used also exhibit much lower 100g peel temperatures than the present invention (WO97/33921, page 74, examples 81-85; page 80, examples 100-104). Therefore, the skilled artisan would find it obvious to ONLY utilize the commercially available resins taught by WO97/33921 and have it function in the expected manner--the manner taught by WO97/33921. Again, absent the knowledge of Applicants' own invention, there is no teaching or suggestion in WO97/33921 and/or in the then-accepted knowledge that would have motivated a skilled artisan to modify WO97/33921 in the manner claimed, and there is no reasonable expectation of success in the manner opposite to what has taught by WO97/33921.

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Accordingly, Applicants submit that the rejection of claims 1-30 under 35 U.S.C.103 (a) over WO97/33921 is unwarranted and request that it be withdrawn.

In view of all the forgoing, Applicants submit that claims pending in the application are in condition for allowance and action in accordance therewith is respectfully requested. In the event that claims are not allowed, Applicants specifically request a personal or telephonic interview if doing so would facilitate the prosecution of the application to allowance.

Respectfully submitted,

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